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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,650	09/15/2003	Yoichi Kanai	242873US2	9352
22850	7590	07/02/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			MILIA, MARK R	
1940 DUKE STREET				
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER
			2625	
		NOTIFICATION DATE	DELIVERY MODE	
		07/02/2008	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/661,650	<b>Applicant(s)</b> KANAI ET AL.
	<b>Examiner</b> Mark R. Milia	<b>Art Unit</b> 2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 March 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6,12-15,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 16-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6,12-15,21 and 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment was received on 3/14/08 and has been entered and made of record. Currently, claims 1-6, 12-15, and 21-22 are pending.

***Claim Rejections - 35 USC § 101***

2. Applicant's amendment to claims 1-6, 12-15, and 21-22 has overcome the rejection set forth in the previous Office Action. Therefore the rejection has been withdrawn.

***Response to Arguments***

3. Applicant's arguments filed 3/14/08 have been fully considered but they are not persuasive.

Applicant asserts that Pensak (US 6,289,450) fails to disclose wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document. The examiner respectfully disagrees as Pensak does disclose such a feature. Particularly, at the top of page 9 of the applicant's remarks, it states that the print requirement indicates to modify the print mode so as to

add one or more of a security level stamp, *a digital watermark*, and a background dot pattern as illustrated in Fig. 5, emphasis added. Pensak states that authoring user **208** can set an option that would enforce a watermark on printing a registered document (see column 6 lines 50-60 and column 8 lines 45-56). Therefore, Pensak clearly discloses wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-6, 12-15, and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,289,450 to Pensak et al., cited in the IDS filed 2/9/04.

Regarding claim 1, Pensak discloses a document printing program encoded on a computer readable medium, comprising the codes of: obtaining a print requirement associated with a document file (see column 6 lines 18-60) and compulsory executing the print requirement when the document file is printed out (see column 6 lines 50-55 and column 8 lines 47-56), wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56).

Regarding claim 12, Pensak discloses a document protecting program encoded on a computer readable medium, comprising the codes, of: obtaining an encryption key

used to encrypt a document file (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), associating print requirement with the document file (see column 6 lines 18-60 and column 8 lines 47-56), and encrypting the document file by the encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56).

Regarding claim 21, Pensak discloses a document protecting system comprising: a distributor terminal implementing a document protecting program encoded on a computer readable medium comprising the codes of: a part obtaining an encryption key to encrypt a document file (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), a part associating a print request to the document file (see column 6 lines 18-60 and column 8 lines 47-56), and a part encrypting the document file by the encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), and a user terminal (see Figs. 1 and 2) implementing a document printing program comprising the codes of: a part obtaining a decryption key of document file being encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), a part decrypting the document file based on the obtained decryption key (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), a part obtaining a print requirement associated with the

document file (see column 6 lines 18-60 and column 8 lines 47-56), and a part executing a printing process so as to satisfy the print requirement (see column 8 lines 35-56), wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56).

Regarding claim 22, Pensak discloses a document protecting system comprising: a server implementing a document protecting program encoded on a computer readable medium comprising the codes of: obtaining an encryption key used to encrypt a document file (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), associating a print requirement with the document file (see column 6 lines 18-60 and column 8 lines 47-56), and encrypting the document file by the encryption key (see column 2 lines 10-28, column 4 lines 10-23 and 53-67, column 5 lines 59-65, column 6 lines 31-60, and column 7 lines 7-36), and a user terminal (see Figs. 1 and 2) comprising the codes of: obtaining a decryption key of a document being encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), obtaining a print requirement associated with the document (see column 6 lines 18-60 and column 8 lines 47-56), and executing a printing process so as to satisfy the obtained print requirement (see column 8 lines 35-56), wherein the print requirement sets a print mode including at least one security requirement to be executed to a to-be-printed document (see column 6 lines 50-60 and column 8 lines 46-56).

Regarding claim 2, Pensak further discloses wherein the print requirement is compulsory enforced by executing a printing process with the print requirement when the document file being encoded is decrypted (see column 8 lines 35-56).

Regarding claim 3, Pensak further discloses obtaining a decryption key for the document file being encrypted (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), decrypting the document file based on the obtained decryption key (see column 2 lines 33-38 and 44-57, column 3 lines 12-15 and 23-25, and column 8 lines 7-60), obtaining the print requirement associated with the document file (see column 6 lines 50-55 and column 8 lines 47-56), and executing a printing process so as to satisfy the obtained print request (see column 6 lines 50-55 and column 8 lines 47-56).

Regarding claim 4, Pensak further discloses wherein the print requirement is obtained from the decrypted document file (see column 6 lines 50-55 and column 8 lines 47-56).

Regarding claim 5, Pensak further discloses wherein a password corresponding to an encryption key used to encrypt the document file is obtained from a user, and an decryption key is generated by the password (see column 2 lines 10-18, column 3 lines 62-65, column 5 lines 59-65, and column 6 lines 17-22 and 31-60).

Regarding claims 6 and 15, Pensak further discloses wherein a parameter, which is internally maintained or generated, is used to generate the decryption key (see column 2 lines 44-57 and column 3 lines 11-25).

Regarding claim 13, Pensak further discloses wherein the document file and the print requirement are associated with each other by providing the print requirement to the document file and then encrypting the document file with the print requirement (see column 6 lines 31-60).

Regarding claim 14, Pensak further discloses wherein an encryption key is generated based on a password input by a user (see column 3 lines 62-65).

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571)272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/David K Moore/  
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